

||
HAEBERLI
Application No.: 09/560,222
Page 5

PATENT

REMARKS

The Office Action of August 4, 2004 rejected claims 112-135 under Section 103(a) as unpatentable over Garfinkle(USPN 6,017,157) in view of Official Notice.

Garfinkle relates to a method of processing a digital image and distributing a visual print produced from the digital image. The method includes the steps of storing the photographic image on an image server at a first location. Selective authorized access to the digital image from a second location is then facilitated. Orders are received for a visual print of the image from the second location. Based upon the order a visual image is produced from the stored digital image at the first location in response to the order.

In regards to claim 112, the Office Action noted that:

Garfinkle discloses receiving a first image from a receiving a request for a demonstration of an image-based product by the user (FIG 5B);

Garfinkle teaches processing digital photos along with delivering and storing digital image products on a server for a customer to upload and download images to a client computer for modification of attributes of the digital image from a client computer (col 7, lines 4-42) and plurality of products (thumbnails, gifts, col 7, lines 53-60), but does not specifically mention that the attributes are automatically selected and presented to the user. It would have been obvious to a person having ordinary skill in the art to include in Garfinkle, automatically demonstrating a product with modifications available, since it has been held that broadly providing a mechanical or automatic means to replace manual activity, which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192. Garfinkle would have been motivated to incorporate the demonstration of a product, because this is a notoriously well known method for showing a product for sale that is modified from its original presentation; for example, showing the tee shirt or mug of Garfinkle with the image shown on it provides for an excellent way for people to visualize the product and thus increase the likelihood of a sale.

Applicant may argue that the manipulation of the product attributes occurs not on the server, but at the client computer. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to (describe modification), since it

HAEBERLI

Application No.: 09/560,222

Page 6

PATENT

has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Similar to Enomoto, Garfinkle requires a user to make all decisions. In contrast, claim 112 relates to a method for automatically demonstrating a product feature associated with a plurality of image-based products, each image-based product having one or more product attributes and the claims recite

- receiving a first image from a user;
- receiving a request for a demonstration of an image-based product by the user;
- automatically selecting one of the plurality of image-based products by a computer;
- automatically selecting at least one of the product attributes for the selected image-based product; and
- automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user.

Garfinkle requires operations to be done manually by a user (e.g., where the user actuates one or more controls in order to select which product attributes to change and/or to select a new value for the selected attributes). In contrast, the claimed invention does not require user intervention, but is about automatically demonstrating a product feature associated with a plurality of image-based products by automatically selecting one of the plurality of image-based products by a computer; automatically selecting at least one of the product attributes for the selected image-based product having the selected product attributes using the image provided by the user.

As shown in Table I in the following page, Garfinkle is completely silent on having computers automatically make selections of image-based products and product attributes:

HAEBERLI

Application No.: 09/560,222

Page 7

PATENT**Table I. Comparisons of Garfinkle, the instant Application and Office Action Assertion**

Garfinkle disclosure	Claim	Office Action Assertion
<p>User provides images</p> <p>User makes decisions on selecting products to be produced from the images, and</p> <p>User makes decisions on selecting properties for the products</p>	<p>A method for automatically demonstrating a product feature associated with a plurality of image-based products, each image-based product having one or more product attributes.</p> <p>The computer receives a first image from a user; receive a request from the user for a demonstration of an image-based product. The process then automatically selects one of the plurality of image-based products by a computer; and automatically selecting at least one of the product attributes for the selected image-based product. The computer then automatically processes a first preview image of the selected image-based product having the selected product attributes using the image provided by the user.</p> <p>The invention thus allows a computer to select and render a quickly preview what a final product COULD look like</p>	<p>It is obvious that computer can automatically make decisions for the user to select products and product attributes.</p>

HAEBERLI

Application No.: 09/560,222

Page 8

PATENT

	without user specifying the details of the preview. The user can still manually makes his/her own decisions on image product or product attributes.	
--	---	--

One embodiment of the invention is described as follows:

As noted above, the system 100 can automatically select which product attributes to change and select new values for the selected product attributes. In one implementation shown in FIGS. 16 and 17A-17B, a user can cause the system 100 to automatically select which product attributes to change and the new values for the selected product attributes by actuating a user interface control such as a button. FIG. 16 is a flow diagram of process of causing a system 100 to automatically select which product attributes to change and the new values for the selected product attributes. First, a user interface control is displayed (block 1602). The user interface control can be any user interface element by which a user can initiate a command. Examples include a button, menu, menu item, command line, key sequence, selection box, and icon. Specification at Page 28, lines 5-14.

Here, Garfinkle does not show each and every element of the claim, namely Garfinkle fails to show at least automatically selecting one of the plurality of image-based products by a computer; automatically selecting at least one of the product attributes for the selected image-based product; and automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user.

Even with the Official Notice, there is no showing the specifics of a method for automatically demonstrating a product feature associated with a plurality of image-based products, each image-based product having one or more product attributes, comprising receiving a first image from a user; receiving a request for a demonstration of an image-based product by the user; automatically selecting one of the plurality of image-based products by a computer; automatically selecting at least one of the product attributes for the selected image-based product; and automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user. Hence, the references singly or in combination cannot render independent claim and those dependent therefrom obvious.

Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either

HAEBERLI

Application No.: 09/560,222

Page 9

PATENT

in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

Applicants submit that there is no suggestion to modify Garfinkle to arrive at the invention as claimed. There is no reasonable expectation of success. Moreover, the reference does not teach or suggest all the claim limitations in the independent claims as well as each dependent claims. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Garfinkle, there is an inference that it came from Applicants' disclosure.

In sum, since none of the references show the claimed elements recited in the claims, Applicant submits that they cannot render obvious independent claim 112. The dependent claims are allowable since they depend from allowable independent claims.

CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested. If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

||
HAEBERLI

Application No.: 09/560,222

Page 10


Bao Tran

PATENT

Reg. 37,955

Tran & Associates

6768 Meadow Vista Court

San Jose, CA 95135

Tel 408-528-7490

Fax 408-528-1490